

understood. There does not appear to be any alternative permitted by the rules to delete subject matter in the present situation by any means other than enclosing that subject matter in brackets. Under 1.173 (b) “each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section ...” Under section (d) “The matter to be omitted by reissue must be enclosed in brackets.” Thus, it is not understood what must be done to comply with both the rules and the Office Action. Clarification is requested. In order to avoid any further confusion in this regard, the examiner is hereby authorized to make an examiner’s amendment to conform the form of the amended claims to the requirements of both 37 CFR 1.173 and the Office Action.

## **II. REPLY TO REJECTION OF CLAIMS 25-39 ON THE GROUND OF IMPROPER RECAPTURE**

### **A. Summary of the Rejection**

Claims 25-39 have been rejected under 35 USC §251 as being an improper recapture of broadened claimed subject matter “surrendered” in the application for the patent upon which the present reissue application is based. The Office Action alleges that these claims are “broader with respect to using isotopic taggant or defining the species of the isotopic ratios that were argued in the rejection of the initial claims in the parent application.” The Office Action continues by alleging two types of narrowing amendments, i.e., that the claims were amended to include the following limitations:

1. “Wherein said abundance ratio being unchanged by chemical reactions.”
2. Requiring the term “abundance” to be “isotopic abundance.”

However, as will be shown in detail below this narrowing of claim scope is not relevant to the recapture issue presented in this application. While it is true that the claims were narrowed in this aspect during prosecution, they were narrowed from a starting point that was narrower than

the scope of the claims now presented for examination in this reissue. Thus, the subject matter at issue was never “surrendered” during the original prosecution, as will be discussed in detail below.

**B. The Broadened Aspect of Claims 25-39 Is Broader than the Corresponding Broadest Aspect of Any Claim Prosecuted in the Original Application and Therefore Can Not be “Surrendered” Subject Matter**

In regard to the recapture rejection, the relevant aspect of the claims at issue is the identity of the taggants. In the original application the taggant was always required to be an isotopic taggant. Claim 1, for example, requires the taggant to have at least two elements and that each element had “at least two stable isotopes.” Original application claim 1 is set forth below for convenience.

1. A method of tagging a substance for identification comprised of:
  - a.) isolating and assigning an identification code to the substance to be tagged,
  - b.) adding to the substance a taggant comprised of at least two elements, each element having at least **two stable isotopes** in a selected artificial abundance ratio,
  - c.) maintaining a tagging record showing the correlation between the selected isotopic abundance ratio of each element in the taggant and the assigned identification code of the substance,
  - d.) measuring the isotopic abundance ratio of each element of the taggant in the substance, and

- e.) comparing the results of the measurement with the tagging records to identify the assigned identification code of the substance. [Emphasis added]

Each and every one of the other originally-filed claims also has terms that limit the scope of the claim in this aspect to an isotopic taggant. Thus, in the remaining independent claims, i.e., claims 2, 3 and 4, the taggant must include “at least two stable isotopes . . .”; and in claim 5 the taggant must include “two or more stable isotopes . . .”

None of rejected claims 26-32 or 36-39 require the taggant to be isotopes. Rather, this aspect of the rejected reissue claims is much more broadly directed to “a taggant representative of an identification code.” All of these claims are “non-isotopic” because none requires the taggant to be an isotope. Thus, all of these rejected reissue claims are broader in this aspect than is any of the claims prosecuted in the original application. These reissue claims can not be considered to be a recapture of surrendered subject matter because such subject matter was never presented for examination in the original prosecution.

In applying the law of recapture, it is fundamental that the subject matter at issue must have been presented for examination at some point in the original prosecution, and then the scope of that claimed subject matter narrowed during the original prosecution. Here no “non-isotopic” taggant subject matter was presented in the original application. There was no admission in the original prosecution that “non-isotopic” taggant subject matter was not patentable. Non-isotopic taggant subject matter therefore could not have been surrendered in response to any rejection made in the original prosecution.

In this regard the issue in the present application is like that in *In re Doyle*, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002). While Doyle presented in a reissue application filed

within two years of the original patent issue date claims that were broader than claims that he had abandoned during the original prosecution, Doyle's reissue application claims were also broader than any claim presented for examination in the original prosecution. In reversing the final rejection made to those broader claims, the Federal Circuit emphasized that the new reissue claims encompassed not only subject matter in claims that had been abandoned in the original prosecution, but also encompassed subject matter that was substantially broader those abandoned claims. The error in Doyle's original patent was essentially the same as the error in applicant's original patent, and made the basis for the present application for reissue: failure to broadly claim at any point in the original prosecution an aspect of the inventive subject matter as broadly claimed in the reissue application. This is just a particular way of expressing one of the statutory grounds for a reissue: the applicant failing to claim in the original patent the subject matter that he had a right to claim. In Doyle the aspect of the inventive subject matter at issue was a broad class of catalysts; in the present application the aspect of the inventive subject matter at issue is non-isotopic taggants. The outstanding rejection here should be withdrawn for the same reason that the final rejection was reversed by the Federal Circuit in *Doyle*. In this regard see also *C.R. Bard, Inc. v. M3 Sys, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998) (reissue application can be used to present for the first time claims to a sub-combination of a previously claimed combination).

**III. REPLY TO REJECTION OF CLAIMS 25, 27-36, 38 and 39 UNDER 35 U.S.C. § 103(a)**

Claims 25, 27-36, 38, 39 are rejected as being unpatentable over Soberman et al (4363965) in view of Winnik, et al (5271764) and Goldblatt, et al (3788814). The examiner argues that Soberman et al discloses using isotopes as taggant sand that they contemplate (Col 1,

Lines 14-15) using their invention on tax stamps and currency “which implies the use of taggants in ink.” However, Soberman et al never explicitly state that their invention could be used in ink. This possibility is, in fact, excluded in Col 6 lines 4-5 where they explicitly state that the Mossbauer effect occurs only in crystalline solids and glasses, but not in liquids. They must, therefore, have contemplated incorporating the Mossbauer taggants into currency and tax stamps by some other means, perhaps by incorporating solid particles in the paper.

The examiner further argues that Winnik et al discuss a system of taggants that contain coded information. It appears, however, that Winnik et al envision using taggants only to control the visibility of images on their documents. The images are “coded” only in the sense that they are printed with inks that are invisible to the naked eye, and are rendered visible by using suitable lighting conditions. Thus the images are “coded” only in the sense that they are not apparent to the casual observer. The composition of the taggant is not representative of an identification code.